UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,816	10/20/2003	Prithipal Singh	11884/408201	4375

26646   7590   02/16/2007

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
	10/689,816	SINGH ET AL.
Office Action Summary	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>16 April 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-24</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>20 October 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the communications filed on 16 April 2004.

2. Claims 1-24 are pending in the application.

3. Claims 1-24 have been rejected.

Specification

4.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract exceeds the 150-word limit.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 18-22 are directed towards a computer readable medium including a method for capturing an electronic signature of a user in a java based environment on a personal digital assistant. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under Sec. 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting").

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-8, 10-17 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kadaba et al U.S. Patent No. 6,285,916 B1.

As to claim 1, Kadaba et al discloses a method for capturing an electronic signature of a user in a java based environment on a personal digital assistant, comprising:

capturing an instance of the electronic signature on the canvas [column 5, lines 44-55];

encoding by a canvas the instance of the electronic signature in a file [column 5, lines 44-55]; and

transferring the file by the canvas to an applet [column 5, lines 44-55].

As to claims 2 and 14, Kadaba et al discloses attaching a pointer to the file by the applet [column 8 line 47 to column 9 line 21]. Kadaba et al discloses the pointer pointing to a business object associated with the electronic signature [column 8 line 47 to column 9 line 21].

As to claims 3 and 15, Kadaba et al discloses communicating by the personal digital assistant the file and the business object to a server [column 7, lines 5-16].

As to claims 4 and 16, Kadaba et al discloses encoding the file and the business object prior to communicating the file and the business object to the server [column 7, lines 5-16].

As to claims 6 and 17, Kadaba et al discloses comparing the file to at least one stored file by the server for consistency [column 7, lines 5-16].

As to claim 7, Kadaba et al discloses producing a rejection message if the server determines that the file and the at least one stored file are not consistent [column 9, lines 22-55].

As to claim 8, Kadaba et al discloses producing an acceptance message if the server determines that the file and the at least one stored file are consistent [column 9, lines 22-55].

As to claim 10, Kadaba et al discloses that the prompting by the applet is in response to a delivery of an item, the electronic signature verifying receipt of the item [column 5, lines 44-55].

As to claim 11, Kadaba et al discloses the method further comprising:

> prompting the user by the applet operating on the personal digital assistant [column 5, lines 44-55]; and

> handling the canvas by the applet [column 5, lines 44-55].

As to claim 12, Kadaba et al discloses a personal digital assistant, comprising:

> a pressure sensitive screen [column 5, lines 44-55]; and

> a processing system adapted to capture a signature entered via the screen and attach the signature to a business object maintained by the processing system [column 5, lines 44-55].

As to claim 13, Kadaba et al discloses the personal digital assistant, wherein:

the application includes an applet adapted to prompt a user and adapted to handle a canvas [column 5, lines 44-55]; and

the canvas is adapted to capture an instance of the electronic signature, encode the instance in a file, and transfer the file to the applet [column 5, lines 44-55].

As to claim 24, Kadaba et al discloses a network, comprising:

a mobile device adapted to capture a signature, encode the signature, and attach the encoded signature to a business object [column 5, lines 44-55]; and

a server adapted to receive the encoded signature attached to the business object from the mobile device [column 7, lines 5-16];

wherein the server compares the encoded signature to a stored signature file [column 7, lines 5-16].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba et al U.S. Patent No. 6,285,916 B1 as applied to claim 1 above, and further in view of Applied Cryptography (hereinafter Schneier).

As to claim 5, Kadaba et al does not teach that the file and the business object are

encoded using an MD5 algorithm.

Schneier teaches the use and benefits of encoding using the MD5 algorithm [page 440].

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Kadaba et al so that the file and the business

object would have been encoded using an MD5 algorithm.

It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to have modified Kadaba et al by the teaching of Schneier because MD5 has

a fourth round added, each step has a unique additive constant and each step now adds in the

result of the previous step which promotes faster avalanche effect [page 440].

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba et al U.S. Patent No. 6,285,916 B1 as applied to claim 1 above, and further in view of Burger et al U.S. Patent No. 6,938,051 B1.

As to claim 9, Kadaba et al does not teach that the file is a .gif file.

Burger et al teaches the use and benefits of using a .gif file [column 16, lines 7-37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kadaba et al so that the signature would have been stored as a .gif file.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kadaba et al by the teaching of Burger et al because GIF offers clarity and lack of noise on text segments at the expense of increased file size [column 16, lines 7-37].

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba et al U.S. Patent No. 6,285,916 B1 in view of Burger et al U.S. Patent No. 6,938,051 B1.

As to claim 18, Kadaba et al discloses a computer readable medium including a method for capturing an electronic signature of a user in a java based environment on a personal digital assistant, the method comprising:

providing a canvas by an applet [column 5, lines 44-55];

prompting the user by the applet to sign the canvas [column 5, lines 44-55];

capturing the electronic signature by the canvas [column 5, lines 44-55];

transferring the formatted electronic signature to the applet from the

canvas [column 5, lines 44-55].

Kadaba et al does not teach encoding the electronic signature in the canvas in a .gif

format to form a formatted electronic signature.

Burger et al teaches the use and benefits of using a .gif file [column 16, lines 7-37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Kadaba et al so that the signature would have

been stored as a .gif file.

It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to have modified Kadaba et al by the teaching of Burger et al because GIF

offers clarity and lack of noise on text segments at the expense of increased file size [column 16,

lines 7-37].

As to claim 19, Kadaba et al teaches that the method further comprises attaching a pointer

to the file by the applet [column 8 line 47 to column 9 line 21]. Kadaba et al teaches the pointer

pointing to a business object associated with the electronic signature [column 8 line 47 to column

9 line 21].

As to claim 20, Kadaba et al teaches that the method further comprises communicating

by the personal digital assistant the file and the business object to a server [column 7, lines 5-16].

As to claim 21, Kadaba et al teaches that the method further comprises encoding the file

and the business object prior to communicating the file and the business object to the server

[column 7, lines 5-16].

As to claim 22, Kadaba et al teaches that the method further comprises comparing the file

to at least one stored file by the server for consistency [column 7, lines 5-16].

10. **Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba et al**

U.S. Patent No. 6,285,916 B1 in view of Applied Cryptography (hereinafter Schneier).

As to claim 23, Kadaba et al discloses a secure signature capturing method for mobile

devices, comprising:

> pursuant to a first application executing on a mobile device, capturing a
>
> signature [column 5, lines 44-55]; and
>
> pursuant to a second application executing on the mobile device, receiving
>
> the signature from the first application and attaching it to a document [column 6,
>
> lines 40-65];
>
> wherein unencrypted data representing the captured signature is
>
> inaccessible to any application other than the first application [column 6, lines 40-
>
> 65].

Kadaba et al does not teach encrypting the signature.

Schneier teaches the use and benefits of encryption [pages 1-2].

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Kadaba et al so that the signature would have

been captured and then encrypted. After receiving the encrypted signature it would have been

attached to a document.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kadaba et al by the teaching of Schneier because encryption offers authentication, integrity and nonrepudiation [page 2].
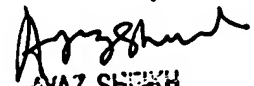
Conclusion

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy
February 13, 2007

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100